

Application Serial No. 10/522,322
Reply to Office Action of August 19, 2008

PATENT
Docket: CU-4060

REMARKS

In the Office Action, dated August 19, 2008, the Examiner states that Claims 17-32 are pending, Claim 30 is objected to, and Claims 17-32 are rejected. By the present Amendment, Applicant cancels the claims and adds new Claims 33-63.

Claims 16-29 are rejected under 35 U.S.C. 112, second paragraph, for the reasons of record. Solely in the interest of advancing prosecution and without prejudice or disclaimer of the subject matter thereof, Applicant has cancelled Claims 16-29 making the rejection of these claims moot. As such, Applicant respectfully requests withdrawal of the rejection of Claims 16-29 under 35 U.S.C. 112, second paragraph.

Claims 16-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Lifesavers (GB 1 526 020). Applicant respectfully disagrees with and traverses this rejection.

At the outset, Applicant indicates that Claims 17-32 have been cancelled, solely in the interest of advancing prosecution and without prejudice or disclaimer of the subject matter thereof, rendering rejection of these claims moot. New Claims 33-63 have been added and Applicant respectfully asserts that these claims are not anticipated by or obvious over the cited prior art for the following reasons.

The confectionery article as presently claimed is now based on a defined combination of herbal extracts or on a defined herbal extract, the herbs therein being peppermint, sage, yarrow, and thyme supplemented with an extract of *Stevia rebaudiana*.

It is recognized that Lifesavers mentions "oil of peppermint", "oil of sage", "thyme oil", and "*Stevia rebaudiana* (Stevioside)" as possible components of chewable pressed tablets containing xylitol and one or more other polyhydric alcohols and polyols as main ingredients. However, Applicant respectfully asserts that Lifesavers fails to disclose yarrow as possible component. Moreover, the inventive combination of herbs is not based on highly purified oils as disclosed by Lifesavers and the supplemented *Stevia rebaudiana* extract is not equivalent to the "Stevioside" component of Lifesavers since the Stevioside component requires an antecedent complex purification process and therefore does not display the same taste changing properties as the extract (cf. US 2005/0260328, p. 1, [0010] and

Application Serial No. 10/522,322
Reply to Office Action of August 19, 2008

PATENT
Docket: CU-4060

[0011]).

As such, Applicant respectfully asserts that Lifesavers does not teach or suggest each and every feature of the newly presented claims set. Accordingly, Applicant asserts that the newly presented claims are not anticipated by Lifesavers.

Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lifesavers. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lifesavers in view of Bell et al. (US 5,338,809). Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lifesavers in view of Zhao (US 2001/0002269). Applicant respectfully disagrees with and traverses these rejections.

New Claims 59-61 correspond to cancelled Claims 30-32 but have been amended to refer to defined herbs or extracts thereof, the herbs being peppermint, sage, yarrow, and thyme. In view of the defined inventive herbal combination it is clear that Lifesavers does not provide any motivation for one of ordinary skill in the art to choose said combination since this combination is not disclosed by Lifesavers (cf. item (II)). Furthermore, Lifesavers does not teach the person skilled in the art to use dried herbs and direct extracts thereof but rather their purified oils and, in particular, sweeteners (Stevioside) all of which display different taste developments and taste properties (cf. US 2005/0260328 A1, p. 1, [0011]) in comparison with the direct extracts.

To support a *prima facie* case of obviousness, the Office Action must establish "a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference." Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (Oct. 10, 2007).

In view of the foregoing explanation, Applicant respectfully asserts that Lifesavers can not properly be used as a sole reference under 35 U.S.C. 103(a) as it does not teach or suggest each and every feature of the new claims.

In addition, the chewable pressed tablets of Lifesavers contain xylitol as a main ingredient, a known sugar substitute and sweetener, and Stevioside is only introduced as an additive, latter being explicitly tagged as synthetic sweetener (cf. GB 1526020, p. 1, 82). Applicant respectfully asserts that the person skilled in the

Application Serial No. 10/522,322
Reply to Office Action of August 19, 2008

PATENT
Docket: CU-4060

art would never regard the extract obtained from a simple and direct (water) extraction as a synthetic component.

As such, Applicant respectfully asserts that new Claims 59 – 61 should not be rejected as obvious under 35 U.S.C. 103(a) over Lifesavers.

The Office Action asserts that Claim 27, now appearing as new Claims 51 to 54, is obvious over Lifesavers (GB 1526020) in view of Bell et al. As Lifesavers neither anticipates nor renders the inventive combination of herbs and herbal extracts obvious as explained above, the combination Lifesavers in connection with other references cannot serve as basis for objecting to the inventiveness of Claim 27, its subject-matter being now dependent on allowable independent claims.

Additionally, Lifesavers and Bell et al., taken together or alone, do not disclose the inventive herbal combination of the present invention. Moreover, just like Lifesavers, Bell et al. is labeling the *Stevia rebaudiana* component as Stevioside, which the person skilled in the art considers as highly pure synthetic sweetener (cf. Bell, column 4, 1. 37-38).

The Office Action alleges that Claims 28 and 29 are obvious over Lifesavers in view of Zhao (US 2001/0002269 A1, hereinafter "Zhao").

The Applicant has cancelled Claim 28 and the subject matter of Claim 29 has been incorporated into new Claims 55 – 58.

The arguments previously set forth with respect to Lifesavers apply here as well. Moreover, Applicant respectfully asserts that Lifesavers and Zhao, taken together or alone, do not render obvious the inventive herbal combination.

Applicant respectfully emphasizes that all of the cited prior art references are drawn to different articles or products than the inventive confectionary article, namely:

- **Lifesavers:** Chewable pressed tablets containing mainly xylitol and at least one polyhydric alcohol or polyol;
- **Bell:** Chewing gum wherein the flavorants are absorbed releasably on finely divided silica; and
- **Zhao:** Multi-phase beverage for normalizing body composition and fluid metabolism.

All cited references mention certain herbs and *Stevia rebaudiana* only parenthetically rather than naming it as major and central ingredient. Therefore, the person skilled

Application Serial No. 10/522,322
Reply to Office Action of August 19, 2008

PATENT
Docket: CU-4060


in the art would not have found any motivation by any of those references to devise the confectionary article of the present invention. Applicant respectfully asserts that only having cognizance of the present invention, representing an – impermissible – retrospective view, the person skilled in the art might have conceived the idea that the references cited in the current application may be regarded as relevant.

In light of the foregoing response, all the outstanding objections and rejections are considered overcome. Applicant respectfully submits that this application should now be in condition for allowance and respectfully requests favorable consideration.

Respectfully submitted,

November 18, 2008

Date



Attorney for Applicant
Brian W. Hameder
c/o Ladas & Parry LLP
224 South Michigan Avenue
Chicago, Illinois 60604
(312) 427-1300
Reg. No. 45613